FISH & RICHARDSON P.C.

| PRE-APPEAL BRIEF REQUEST FOR REVIEW | Docket Number: |
| | 10664-130002 |

I hereby certify that this paper is being filed with the United States Postal Service using the EFS-WEB system on this date: February 25, 2008.	Application Number	Filed
	10/616,100	July 8, 2003
	First Named Inventor	
	David P. Cook	
	Art Unit	Examiner
	2137	Minh Dieu T. Nguyen

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
        Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
   See 37 CFR 3.71. Statement under 37 CFR 3.73(b)
   is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record 52,713
                        (Reg. No.)

☐ attorney or agent acting under 37 CFR 1.34.
   Registration number if acting under 37 CFR 1.34

_____/Alex Chan/_____
Signature

_____Alex Chan_____
Typed or printed name

_____(650) 839-5070_____
Telephone number

_____February 25, 2008_____
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ Total of 6 pages are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	David P. Cook	Art Unit	: 2137
Serial No.	:	10/616,100	Examiner	: Minh Dieu T. Nguyen
Filed	:	July 8, 2003	Conf. No.	: 1883
Title	:	SECURE MESSAGE FORWARDING SYSTEM DETECTING USER'S PREFERENCES INCLUDING SECURITY PREFERENCES		

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

This brief is filed in response to factual deficiencies in the Final Office Action mailed September 10, 2007. Claims 93-94 and 97-107 are pending in the action, with claims 93, 97, 100 and 106 being independent.

Section 103(a) Rejections

Claim 93 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over **Daniels** in view of **Kobata**. Applicant respectfully traverses this rejection.

Claim 93 recites in part, decrypting an encrypted message at a forwarding server.

In the Final Office Action, the Examiner has asserted that Daniels' message router 112 is the claimed forwarding server, thus suggesting that Daniels' message router 112 operates to decrypt an encrypted message and determine a delivery preference for each recipient in a list of recipients. *See*, page 5, item 5, lines 8-9 of Final Office Action.

Applicant respectfully submits that this claim construction is not supported by Daniels. As discussed extensively at col. 6, line 65 – col. 7, line 39, Daniel's message router 112 receives an electronic mail piece from the electronic inserter 110, and decodes the delivery preference data 322 and 324 from the mail piece (6:65-7:1). After decoding, the message router 112 then sends the electronic mail piece to the output server 113 for actual delivery based upon the decoded data (7:4-6). For example, if the delivery preference data 322 designates a web server 116 as the destination, then the output server 113 sends the electronic mail piece to the web server 116 (7:6-9). Applicant respectfully submits that Daniels' message router 112 does not provide any decryption capability for decrypting an

electronic mail piece. At most, Daniels shows decoding a portion of a message (the preference portion). The Examiner also acknowledges that Daniels is "silent on the capability of decrypting an encrypted message at the forwarding server." *See*, page 3, lines 1-3 of Final Office Action.

Further, claim 1 recites in part, <u>for each recipient that has a delivery preference</u>, re-encrypting the message and delivering the re-encrypted message <u>in accordance with the delivery preference</u>. In the "Response to Argument" section of the Final Office Action, the Examiner maintains that Daniels discloses determining a delivery preference. *See*, page 3, lines 1-3 of Final Office Action.

As a preliminary matter, Applicant reiterates that Daniels' message router 112 has no decryption capability. As such, Daniel's message router 112 does not "re-encrypt" a message because the message was never decrypted in the first place. While the Examiner has shown how Daniels' recipients are provided with delivery preferences, such a showing still does not arrive at the claimed invention because Daniels has provided no teaching or suggestion of delivering a re-encrypted message in accordance with these delivery preferences. The Examiner has conceded that Daniels does not teach or suggest re-encrypting a message. *See*, page 6, lines 6-7 of Final Office Action. Applicant respectfully asserts that Daniels does not teach re-encrypting and more particularly does not teach re-encryption based on preferences of the recipient.

Kobata does not remedy the deficiencies of Daniels. Kobata's sending system 14 sends a parcel 58 to the alleged forward server 26, and notifies the receiving system 18 that the parcel 58 can be retrieved (5:42-47). The alleged forwarding server 26 then, decrypts the parcel and waits until the receiving system 18 to come on-line to request the parcel (7:34-36). Once the receiving system 18 has requested the parcel, the alleged forwarding server 26 encrypts the parcel and transmits the encrypted parcel to the receiving system 18 (13:44-57). Kobata is thus directed to a retrieval process that sends a parcel to a recipient 18 irrespective of, rather than in accordance with, the recipient's delivery preference. While Kobata includes decryption and re-encryption, Kobata does not re-encrypt a message based on a recipient's preferences.

For at least these reasons, Applicant respectfully submits that the proposed combination of Daniels and Kobata does not render claim 93 obvious. Claims 94 and 99 depend from claim 93, and also are allowable for at least the same reasons discussed above with respect to claim 93.

Section 103(a) Rejections

Claim 97 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over **Daniels** in

view of **Kobata**, and further in view of **Owens**. Applicant respectfully traverses this rejection.

Claim 97 recites in part a forwarding engine operable to **notify** the recipient that the message is available for retrieval for **each recipient that does not have a delivery preference**. The Examiner has pointed out Daniels' col. 4, lines 18-23, Kobata's col. 5, lines 43-46, and Owens' col. 4, lines 18-20, col. 5, lines 37-44 and col. 6, lines 52-55 as allegedly disclosing these claimed features. *See*, page 3, lines 6-17 of Final Office Action. Applicant will now address each section below.

Daniels' col. 4, lines 18-23 is directed to sending electronic mail pieces to the message router 112 for delivery in accordance with the addressing information (e.g., to a web server 116, electronic mail address, pager, fax number, etc.). Nowhere in this section does Daniels' provide any teaching or suggestion of notifying a recipient in an event that the recipient does not have a delivery preference. In fact, by stating the various addressing information, Daniels' does not contemplate the situation in which a recipient does not have delivery information. Daniels also does not notify a recipient that the mail piece is available for retrieval if a delivery preference has not been defined. Each mail piece is sent out to the recipient by the output server 113. There is nothing in Daniels that suggests that the output server 113 notifies a recipient that a mail piece is available for retrieval.

Kobata's col. 5, lines 43-46 is directed to sending, by the sending system 14, a notification to the receiving system 18 that a parcel intended for the receiving system 18 is in route to the server system 26, where the parcel can be retrieved. *See also* 5:54-56. Kobata's sending system 14 notifies the receiving system 18 of the parcel in transit regardless of whether the receiving system 18 has or does not have a delivery preference.

Owens' col. 4, lines 18-20 provides that a user may dial into an email mailbox with a computer and playback voice mail messages, view fax mail mesages and read email messages. Owens' col. 6, lines 52-55 provides that after messages arrive at the designated service (e.g., electronic mail service or telecommunications service), the messages may be sent to or stored in mailboxes associated with the individual message receivers for later retrievel by the receiver. Nowhere in these sections does Owen consider recipients that do not have a delivery preference and notify such recipients that messages are available for retrieval. Owens' col. 5, lines 37-44 briefly discusses the option of forwarding an electronic message to the receiver's mailbox if the message receiver does not specify a preference for receiving an incoming message, rather than notifying the recipient that the message is available for retrieval. In fact, by forwarding the message to the receiver's mailbox, Owens effectively eliminates the need to notify the recipient that the message is available for retrieval.

For at least these reasons, Applicant respectfully submits that the proposed combination of Daniels, Kobata and Owens does not render claim 97 obvious. Claim 98 depends from claim 97, and also is submitted to be allowable for at least the same reasons discussed above with respect to claim 97.

Section 103(a) Rejections

Claim 100 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over **Daniels** in view of **Kobata**, and further in view of **Jones**. Applicant respectfully traverses this rejection.

Claim 100 recites in part at the forwarding server, determining a decryption capability for each recipient in the list of recipients. The Examiner admits that Daniels does not teach or suggest these features, and relies upon col. 2, lines 40-46 of Kobata to cure these deficiencies. *See*, page 10, line 19 to page 11, line 6 of Office Action. Applicant respectfully submits that the relied upon section of Kobata only provides an encryption-decryption process for sending a parcel. However, Kobata does not teach or suggest encrypting a parcel based on a recipient's decryption capability.

Claim 100 further recites in part re-encrypting the decrypted message according to the decryption capability of the recipient and delivering the re-encrypted message to the recipient. The Examiner has acknowledged that neither Daniels nor Kobata teach or suggest these features, but relies on col. 4, lines 30-35 of Jones to cure these deficiencies. *See*, page 11, lines 12-19 of Final Office Action. Applicant respectfully disagrees.

Jones describes that the digital content provider 60 may interrogate a user's device 64 to determine the level at which the device 64 is to be trusted with digital content (e.g., music files) so as to limit the user's ability to engage in illegal redistribution of the content (8:53-58). The provider 60 may user the user's public key to encrypt the digital content such that its playback could only be effectuated by the user's device 64 by decrypting the digital content with its private key during playback (8:62-65).

Applicant respectfully submits that while Jones checks the trust level of the user device 64, Jones does not determine the decryption capability of the user device 64. The relied upon portion of Jones does not discuss how decryption capability is determined. Applicant respectfully submits that determining the trust level of a device is wholly distinct from determining the decryption capability of the device, as the determination of the device's trust level relates to authorization while the determination of the device's decryption capability relates to enablement once the trust level has been determined. For at least these reasons, Applicant respectfully submits that the proposed combination of Daniels, Kobata and Jones does not render claim 100 obvious.

Section 103(a) Rejections

Claim 106 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over **Daniels** in view of **Kobata** and **Jones**, and further in view of **Bengtsson**. Claim 106 recites in part a forwarding engine operable to <u>determine whether the recipient has a decryption capability</u> for each recipient in the list of recipients, <u>re-encrypt the message according to the decryption capability of the recipient</u> for each recipient with a decryption capability, and <u>notify the recipient that the message is available for retrieval</u> for each recipient that does <u>not</u> have a decryption capability.

The Examiner previously admitted that neither Daniels, Kobata nor Jones teach or suggest these features. *See*, page 14, line 21- page 15, line 5 of First Office Action. To cure these deficiencies, the Examiner relies upon Bengtsson's col. 5, lines 22-34 and lines 43-55 (and col. 6, lines 60-67), alleging that Bengtsson's server 32 can deliver sender's SMS message and attachment in a format that can be deciphered by the receiver terminal 34 if the receiver terminal 34 does not have the capability to decipher the SMS message and attachment. *See*, page 4, line 18- page 5, line 3 of Final Office Action. Applicant respectfully submits that reformatting a message so that the message can be deciphered by the receiver terminal 34 does not mean that the message is being encrypted or re-encrypted according to the receiver terminal's decryption capability. In fact, Bengtsson describes that the SMS attachment may be accessed as an ordinary HTML file if the receiver terminal 34 cannot decipher the attachment, evidencing that the message is being reformatted according to the format compatibility, not decryption capability, of the receiver terminal 34.

For at least these reasons, Applicant respectfully submits that the proposed combination of Daniels, Kobata, Owens and Bengtsson does not render claim 106 obvious. Claim 107 depends from claim 106, and is allowable for at least the same reasons discussed above with respect to claim 106.

The pre-appeal brief fee in the amount of $255 is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date:February 25, 2008

/Alex Chan/
Alex Chan
Reg. No. 52,713

Customer No. 26181
Fish & Richardson P.C.
Telephone: (650) 839-5070
Facsimile: (650) 839-5071

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